

Application No. 09/09/803,191  
Response  
Reply to Office Action of September 4, 2003  
Inventor(s) Name: Ian Alastair Kirk et al.  
Attorney Docket No.: 717901.3

### **REMARKS**

#### **Rejection Under 35 U.S.C. Section 103:**

Claims 1-3 and 5-8 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Mikolajczyk (U.S. Patent No. 5,095,981) or Stolz (U.S. Patent No. 1,805,050) or Bettis (U.S. Patent No. 2,166,116) in view of Myers (U.S. Patent No. 6,039,127) or Wilde (U.S. Patent No. 6,258,180).

The Examiner considers it obvious to one of ordinary skill in the art to make the centralizer of Mikolajczyk, Stolz, or Bettis, of austempered ductile iron as it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice *In re Leshin*, 227 F.2d 197, 125 U.S.P.Q. 416 (C.C.P.A. 1960).

To demonstrate to the Examiner that such a combination was not a matter of obvious design choice we enclose a Declaration from Ian Kirk (Inventor) detailing the difficulty experienced in manufacturing such a centralizer.

From this Declaration it is submitted:

1) The Castings Development Centre (formerly BCIRA) are specialists in leading edge technology through R&D, and failed to manufacture a suitable centralizer despite 44 years of experience (see their website [www.castingsdev.com](http://www.castingsdev.com)). It is submitted to the Examiner that the expertise at The Castings Development Centre is greater than one of ordinary skill in the art and

that given they failed to succeed in manufacturing a centralizer made from ADI then an ordinarily skilled person would inevitably fail to manufacture a centralizer made from ADI.

2) Similarly, The Taylor Group being specialists in Ductile and Austenitic Iron castings also failed to manufacture a centralizer made from ADI. It is also submitted that the expertise at The Taylor Group is greater than one of ordinary skill in the art and that given they failed to succeed in manufacturing a centralizer made from ADI then an ordinarily skilled person would inevitably fail to manufacture a centralizer made from ADI.

3) Given the difficulties and time involved in finally developing centralizers made from ADI, it would not be a routine design choice. Nevertheless, should a skilled person attempt to make a centralizer made from ADI, they would quickly be dissuaded from continuing and therefore fail to make such a centralizer because of the difficulties encountered by the present inventors, The Castings Development Centre and The Taylor Group.

4) The worldwide commercial success of the centralizer demonstrates that, if this was an obvious design choice, it would have been made before this date. In particular, it is noted that the Assignee's have invested considerably in the United States, manufacturing such centralizers there and indeed incorporated a U.S. company to sell their centralizers.

Applicants have considered *In re Leshin*, 227 F.2d 197, 125 U.S.P.Q. 416 (C.C.P.A. 1960) and do not contest the precedent set down by this case. However, Applicants do contest the applicability of this precedent in the present Application. Head note 1 of *Leshin* states "Mere selection of known plastics material.... the selection of the plastics material being

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on the basis for intended use, is obvious.” However, in the present Application the inventors did not *merely* select the material but had to overcome numerous difficulties and successive failures in designing the centralizer in order to arrive at the invention claimed, as detailed in the enclosed Declaration. In Leshin, no such difficulties are present - see discussion on Claim 13 (bottom page 417) - Leshin simply submitted that he has had to select the particular plastic material for his particular purpose. In contrast, the present inventors had to persevere with attempting to manufacture such a centralizer against all the difficulties encountered in doing this (in addition to selecting the material).

Thus, it is respectfully submitted that the present Application is not the same point as that held in Leshin because the present inventors have not *merely* selected a suitable material as in Leshin, but have done much more.

Accordingly, the Examiner is respectfully requested to withdraw his objection to Claims 1-3 and 5-8 under 35 U.S.C. Section 103(a).

## **Conclusion**

All objections and rejections have been complied with, properly traversed, or rendered moot. Thus, it now appears that this Application is in condition for allowance. Favorable consideration and allowance are earnestly solicited.

If any issue regarding the allowability of any of the pending Claims in the present Application could be readily resolved, or if other action could be taken to further advance this Application such as an Examiner’s Amendment, or if the Examiner should have any questions

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regarding this present Amendment, it is respectfully requested that Examiner please telephone the Applicants' undersigned attorney in this regard.

Respectfully submitted,

Date:

February 4, 2004



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